REMARKS

With the entry of this amendment, claims 1 to 3 and 6 to 10 appear in the application. Claim 2 has been amended to overcome the rejection of the claim as being indefinite. The limitations of original claims 4 and 5 have been incorporated into claim 1 and, therefore claims 4 and 5 have been canceled. With the cancellation of claim 4, claim 7 has been amended to be dependent on claim 1. Similar limitations as added to claim 1 have been added to claim 10, to correspond to the amendments to claim 1. In addition, the limitations of claim 11 have been incorporated into claim 10. Therefore, claim 11 also has been canceled. These amendments are made to narrow the issues presented for reconsideration by the Examiner. Since the limitations from original claims 4 and 5 added to claims 1 and 10 have been previously considered by the Examiner, no new issues are presented, and entry of this amendment is therefore appropriate.

Claim 2 was rejected under 35 U.S.C. §112, second paragraph, for the reason that there was no antecedent basis for the limitation of "the ID received via the Internet". The suggestion of the Examiner of changing the definite article "the" to the indefinite article –an– has been adopted and, therefore, the rejection is believed to be overcome by this amendment.

Of the several rejections on the prior art under 35 U.S.C. §§102 and 103, the only rejection which has not been made moot by this amendment is the Examiner's rejection of claims 4, 5 and 7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,731,642 to Borella et al. in view of U.S. Patent No. 6,496,867 to Beser et al. and U.S. Patent No. 6,400,719 to Chimura et al. While claims 4 and 5 have been canceled, their limitations have been added to claims 1 and 10. The rejection is again respectfully traversed for the reason that the combination of Borella et al., Beser et al. and Chimura et al. does not suggest the claimed invention.

Arguments were presented in the amendment filed August 26, 2004, which distinguished the disclosed invention over the prior art relied upon by the Examiner. In responding to those arguments, the Examiner has admitted that the disclosed invention is clearly distinct from the prior art but dismissed the arguments as failing to demonstrate that the points argued were not supported by the claim language. As will demonstrated below, the claim language does in fact support the arguments distinguishing the invention from the prior art.

The arguments concerning the prior art set out in the amendment filed on August 26, 2004, are incorporated herein by reference and briefly summarized here.

Borella et al. describe a system and method for Internet telephony between a caller station and a callee station. The caller station is connected to a first edge network via a first telephony interface, and the callee station is connected to a second edge network via a second telephony interface. An intermediate network is connected to the first edge network via a first router and is connected to the second edge network via a second router. The callee station is associated with a callee station number. The first router initiates the call in response to a setup message that includes the callee station number. A first gatekeeper, controlling the first router, and a second gatekeeper, controlling the second router, together mediate the process of setting up the call. A back end server, in communication with the first and second gatekeepers, stores the addresses and station numbers needed to set up the call. During the call, the first router performs network address translation to transmit signals between the first edge network and the Internet, and the second router performs network address translation to transmit signals between the second edge network and the Internet.

Borella et al. do not address the difficulty of penetrating a security firewall to directly address, or call, a LAN-connected telephone from outside the LAN. Discussion of security in Borella et al. is limited to the desirability of preventing unauthorized persons from gaining access to the system to make unauthorized

telephone calls. The Examiner states that "Borella does not disclose *expressly* the limitation that the ID includes a domain name of the telephone controller and identification information" (emphasis added). The use of the adverb "expressly" is misleading as it suggests that there is an implied disclosure of the limitation. In fact, there is no such disclosure, either express or implied.

Beser et al. describe a method for initiating a tunneling association in a data network. The method includes negotiating private addresses, such as private Internet Protocol addresses, for the ends of the tunneling association. The negotiation is performed on a public network, such as the Internet, through a trusted-third-party without revealing the private addresses. The method provides for hiding the identity of the originating and terminating ends of the tunneling association from the other users of the public network. Hiding the identities may prevent interception of media flow between the ends of the tunneling association or eavesdropping on Voice-over-Internet-Protocol calls. The method increases the security of communication on the data network without imposing a computational burden on the devices in the data network

Beser et al. relies on connections made through a tunneling association negotiated by means of a trusted third-party network device. Discussion of security in Beser et al. lacks consideration of this issue and appears to be limited to the desirability of preventing eavesdropping. There is nothing in Beser et al. to enable network-connected telephones to receive calls originating outside the private network 20, except to the extent calls may be received from telephones establishing a connection through a trusted third-party network device 30. The Examiner states that "Borella dn Beser do not disclose *expressly* the limitation of . . . the identification information being composed of a user name and an extension telephone number" (emphasis added). Again, the use of the adverb "expressly" is misleading. In fact, there is no disclosure or suggestion by the combination of Borella et al. and Beser et al. of this limitation.

Chimura et al. disclose a telephone communication method capable of promoting the efficient use of a limited number of IP (Internet Protocol) addresses. When a call is originated on a first telephone terminal, a first gateway accommodating the terminal accesses a DNS (Domain Name System) server via a UDP (User Datagram Protocol) channel of Internet or Intranet. The first gateway inquires the DNS server of the IP address of a second gateway accommodating a telephone terminal to be called, using an office number assigned to the second telephone terminal as a host name. The DNS server returns the IP address of the second gateway to the first gateway via the UDP channel. In response, the first gateway selects its own IP address for speech transfer and sends a call connection request to the second gateway on a TCP (Transmission Control Protocol) channel of Internet. On receiving the request, the second gateway determines whether or not the second telephone terminal is busy, and selects the IP address for speech transfer if it is idle. The IP address selected is returned to the first gateway in the form of a response message. As a result, a connection is set up between the two telephone terminals.

Chimura et al. lacks any discussion of security or firewalls and does not address the difficulty of penetrating a security firewall to directly address, or call, a LAN-connected telephone from outside the LAN. Chimura et al. is directed to a telephone communication method capable of relating a telephone terminal and a speech channel IP address at the time of call connection.

Claim 1, as amended, recites "A telephone controller controlling a plurality of telephones connected to the Internet via a LAN (Local Area Network), said telephone controller *allowing an external telephone connected to the Internet to make a direct call to a telephone in the LAN*" (emphasis added). None of Borella et al., Beser et al. or Chimura et al., taken singly or in combination, address this problem which is solved by the claimed invention. The telephone controller comprises "an IP (Internet Protocol) address allocating circuit which allocates *a private IP address to each of the plurality of telephones*" (emphasis added).

Relating back to the preamble, this is the IP address allocating circuit 122 in Figures 1, 7 and 9 and is part of the solution provided by the claimed invention which allows an external telephone connected to the Internet to make a direct call to a telephone in the LAN. The telephone controller further comprises "a memory in which *a table indicating a correspondence between IDs (Identifier) of the plurality of telephones and the private IP addresses is stored*" (emphasis added). The memory 130 includes table 131 and is also part of the solution provided by the claimed invention which allows an external telephone connected to the Internet to make a direct call to a telephone in the LAN. The telephone controller further comprises "a control circuit which controls communication between the plurality of telephones and the Internet *using the private IP addresses*" (emphasis added). The control circuit 110, as recited, controls communication between the plurality of telephones and the Internet by means of the private IP addresses. None of Borella et al., Beser et al. or Chimura et al., taken singly or in combination, disclose anything analogous to this recitation of the structure of the telephone controller. Claim 1 further recites that "the ID includes *a domain name of said telephone controller* and identification information *composed of a user name and an extension telephone number of the telephone*" (emphasis added). Moreover, claim 1 further recites that the "memory further stores therein *a table indicating a correspondence among the ID, private IP address, extension telephone number, and user name*" (emphasis added). Again, none of Borella et al., Beser et al. or Chimura et al., taken singly or in combination, disclose these features.

The Examiner asserts that he has combined Borella et al., Beser et al. and Chimura et al. "because they are from the same field of endeavor of communication using IP networks"; however, in order to make the combination, the Examiner has had to interpret the claims in such a fashion that specific limitations are not given their proper weight and the prior art read in such a fashion as to declare structure analogous which is clearly not so. The Examiner is reminded of the basic considerations which apply to obviousness rejections as set

out in MPEP 2141. Specifically, "When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

"(A) The claimed invention must be considered as a whole;

"(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

"(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

"(D) Reasonable expectation of success is the standard with which obviousness is determined."

In the present case, the Examiner has used impermissible hindsight to combine references which do not address the problem solved by the claimed invention and, therefore, there can be no valid argument that there can be a reasonable expectation of success in the proposed combination. The mere fact that prior art references are from the "same field of endeavor" does not provide license to the Examiner to combine those references in manner not contemplated or reasonably suggested by those references – there must be some basis independent of applicant's own disclosure for make the combination.

Claim 10 has been amended with the same limitations as found in claim 1 and is patentable over the prior art for the same reasons as advanced above. Claims 2, 3 and 6 to 9, which are dependent on claim 1 are also patentable over the prior art for the reasons advanced above.

In view of the foregoing, it is respectfully requested that this amendment be entered, the application be reconsidered, that claims 1 to 3 and 6 to 10 be allowed, and that the application be passed to issue. In the alternative, it is requested that the amendment be entered for purposes of appeal.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

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